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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/526,391

03/16/2000

Hideki Yamao

FUJ-17.041

1556

7590

03/30/2004

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EXAMINER

BARNIE, REXFORD N

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/526,391

Applicant(s)

YAMAO, HIDEKI

Examiner

REXFORD N BARNIE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*R N Barnie*  
REXFORD BARNIE  
PRIMARY EXAMINER  
03/19/04

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by lee (US pat# 5,517,549).

Regarding claim 7, Lee teaches a transmitter transmitting a signal to a portable telephone to start erasing information stored in the phone by sending an erase command in (see claim 7, claim 14, "erase call log" command in (see col. 9 line 66-col. 10 line 3, col. 10 lines 16-24)).

Regarding claim 8, Lee teaches an external device which can receive a call log and send an erase call log to the portable telephone device as desired by means of a combination of commands including print call log and erase call log command in (see cols. 9-10, claims 7 and 14).

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Krolopp et al. (US Pat# 4,811,377)

Regarding claim 8, Krolopp et al. teaches a secure transfer of radio specific data teaches a transmitter with a memory and a receiver with a memory to receive transmitted information after which the transmitter can erase information stored in its memory in (see disclosure-col. 5 line 55-col. 6 line 8).

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Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Svensson (US Pat# 5,687,216).

Regarding claim 8, Svensson teaches a telephone with a memory wherein the memory information can be transferred to an external memory and the controller automatically erases information stored in its memory based on a user request in (see disclosure).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toru Nishio (08-182052, cited by applicant) in view of Hiroshi Ogasawara (JP 9-252489) and further in view of Lee (US Pat# 5,517,549) or Krolopp et al. (US Pat# 4,811,377) or Smith (US Pat# 4,630,314).

Regarding claim 1, Toru teaches a communication system wherein a portable telephone can have its content updated by a base station with its internal memory which can receive information associated with a portable phone which is transmitted to the base station in (see abstract and figs.). Toru teaches that if a user enters a backup time, this is a request to a communication system that an update is to be performed at a certain time (see disclosure). Toru fails to teach a communication system where an update can be performed without taken into account a time factor.

Ogasawara teaches a communication system wherein a backup request can be made and information stored in a communication device without taking into account a time factor (see abstract)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Ogasawara into that of Nishio thus making it possible to request an information backup anytime desired and having information restored in a telephone device should in case of an abnormality and so forth without having to do so manually.

The combination fails to teach erasing the memory of device, once data has been transferred or received.

Lee teaches a call logging in cellular subscriber stations wherein a call log can be accessed and retrieved from a memory of a telephone device by an external device and erasing the information in the memory in (see claims 7, 14 and col. 10 lines 16-24).

Krolopp et al. teaches a secure transfer of radio data in (see col. 5 line 55-col. 6) that transmitted data to a receiving end causes the data in the transmitter to be erased after being transmitted and received by a receiving unit.

Smith teaches a communication system wherein a transmitting device erases data after it's been transmitted or transferred in (see col. 21 lines 19-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of the secondary references into the combination thus making it possible to conserve memory space, reduce and storage redundancy.

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Regarding claim 2, The combination renders obvious the possibility of storing any information desired in a memory such as conventional data including speed dialing, address book, schedule and so forth.

Regarding claim 3, Toru teaches a communication system wherein a portable telephone can have its content updated by a base station with its internal memory which can receive information associated with a portable phone which is transmitted to the base station in (see abstract and figs.). Toru teaches that if a user enters a backup time, this is a request to a communication system that an update is to be performed at a certain time (see disclosure). Toru fails to teach a communication system where an update can be performed without taken into account a time factor.

Ogasawara teaches a communication system wherein a backup request can be made and information stored in a communication device without taking into account a time factor (see abstract)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Ogasawara into that of Nishio thus making it possible to request an information backup anytime desired and having information restored in a telephone device should in case of an abnormality and so forth without having to do so manually.

The combination fails to teach erasing the memory of device, once data has been transferred or received.

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Lee teaches a call logging in cellular subscriber stations wherein a call log can be accessed and retrieved from a memory of a telephone device by an external device and erasing the information in the memory in (see claims 7, 14 and col. 10 lines 16-24).

Krolopp et al. teaches a secure transfer of radio data in (see col. 5 line 55-col. 6) that transmitted data to a receiving end causes the data in the transmitter to be erased after being transmitted and received by a receiving unit.

Smith teaches a communication system wherein a transmitting device erases data after it's been transmitted or transferred in (see col. 21 lines 19-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of the secondary references into the combination thus making it possible to conserve memory space, reduce and storage redundancy. Note that a request in regard to a phone can be made using a second phone.

Regarding claim 5, the examiner takes official notice that it's known to use ESN and MIN to correctly identify a mobile telephone such as in authentication cases or for remote transfer of data into the phone. Also, known is the fact that a ticket or control number can be generated when one reports a problem with a phone. Also, equally known is the fact that system specific parameters such as control channel number, system identification number (SID) and subscriber parameters such as MIN, ESN and so forth allows communication between a remote means and a subscriber terminal.

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Regarding claim 6, The examiner takes official notice that it's known to store subscriber information or messages in a memory of a network for a time period after which it can be erased. Examples include voice messages and so forth.

2. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toru Nishio (08-182052, cited by applicant) in view of Hiroshi Ogasawara (JP 9-252489) and further in view of Lee (US Pat# 5,517,549) or Krolopp et al. (US Pat# 4,811,377) or Smith (US Pat# 4,630,314) and further in view of Mills (US Pat# 5,915,225).

Regarding claim 4, see the explanation as set forth regarding claim 5 in addition the fact that the combination fails to teach making a request to a phone in a busy state. Mills teaches remotely retrieving SIM stored data over a connection-less communication link where a request can be made to a telephone even in a busy state in (see col. 3 lines 34-53 and so forth). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Mills into that of the combination thus making it possible to program and communicate with a device even in a busy state without having to wait till it goes on-hook.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mills (US pat# 5,915,225) in view of Lee (US Pat# 5,517,549).

Regarding claim 9, Mills teaches a memory storing information to be transmitted to an external device wherein the controller of the portable device will not activate a ring signal given the fact that the telephone is on a communication (busy mode or call waiting) and can transfer information to a remote station in response to a request in



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(see col. 3 and disclosure) but fails to teach the possibility of transmitting detailed collection of information and erasing a memory.

Lee teaches an external device in communication with a telephone device wherein a request can be made for information stored in the phone and can be transmitted to the external device after which the information can be erased if requested by the external device in (see claims 7, 14 and cols. 9-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Lee into that of Mills thus making it possible to update, request and configured telephones even in a busy mode without having to wait till an on-hook mode.

#### **CONCLUSION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **REXFORD N BARNIE** whose telephone number is (703) 306-2744. The examiner can normally be reached on M-F 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CURTIS KUNTZ can be reached on (703) 305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRIMARY EXAMINER  
REXFORD BARNIE  
03/19/04

  
REXFORD BARNIE  
PRIMARY EXAMINER